

Remarks

Currently pending in the application are claims 27-34. Claims 1-26 have been canceled. Applicant respectfully requests entry of the amendments, reconsideration by the Examiner and advancement of this case to allowance.

Rejection under 35 U.S.C. § 102 (e) as anticipated by Penza

The Examiner rejected the claims as being anticipated by Penza (U.S. Pat. No. 6,510,868). Penza teaches line contact, not surface contact, of the sealing element with a seating surface. Furthermore, while Penza claims the use of elastomeric material in a compressor valve, Penza does not teach, describe or suggest any suitable elastomeric material or blend thereof for use in a gas compressor valve and has not enabled the claimed invention. Moreover, Penza does not teach use of an elastomeric material in connection with an unloader.

Rejection of the Claims under 35 U.S.C. § 102 (b) as anticipated by Jainek or Johnson

The Examiner rejected the claims under 35 U.S.C. § 102 (b) as being anticipated by Jainek et al. (U.S. Pat. No. 6,234,194). Examiner has also rejected the claims under 35 U.S.C. § 102 (b) as being anticipated by Johnson et al (U.S. Pat. No. 5,088,521). Neither Jainek et al. nor Johnson et al. disclose an unloader used in connection with a gas compressor. Jainek et al. provides a general teaching of a valve that can be used in liquid services. Johnson et al. teaches a valve for use in a mud pump to circulate drilling mud during well drilling operations.

Rejection under 35 U.S.C. § 103(a) as unpatentable over Penza in view of Jainek and in further view of Bassett

Examiner has rejected the claims under 35 U.S.C. § 103(a) as unpatentable over Penza in view of Jainek and in further view of Bassett.

As mentioned above, Penza teaches line contact and not surface contact of the sealing element with the seating surface. Furthermore, Penza does not teach or describe an unloader and does not enable present invention. Noteworthy, is even if, Penza could be argued as inherently teaching the subject invention, the rejection under 35 U.S.C. § 103 would be made under an improper basis. *See In re Shetty*, 566 F.2d 81, 86, 195 U.S.P.Q. 753, 756-57 (C.C.P.A. 1977)(that which is inherent in the prior art, if not known at the time of the invention, cannot form a proper basis for rejecting the claimed invention as obvious).

Jainek et al. does not disclose or suggest a gas compressor valve. Janiek et al. teachings are directed to a liquid valve or pump. Janiek et al. does not teach or suggest a gas compressor valve or gas compression.

To support a conclusion of obviousness, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teaching of the references. *Ex parte Clapp*, 227 U.S. P.A. 972, (73 (Bd. Pat. App. & Int. 1985) Examiner's reasoning for the rejection is that Penza and Jainek disclose substantially the same seal except a concentric ring valve as taught by Basset. However, Penza's seal is not the substantially same (requires line contact, not surface contact) and does not function substantially the same way as Applicant's seal. In fact, Penza teaches away from the use of surface contact. The cited references do not suggest the claimed combination either expressly or impliedly.

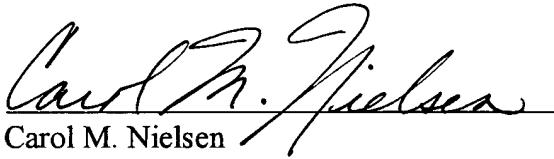
A prior art reference cannot be properly modified or combined with other references without a suggestion or motivation to combine or reasonable expectation of success--none of which is offered by the prior art in the present case. The Examiner has not established a prima

facie case of obvious. There is no motivation to combine these references except through hindsight motivation. The motivation to make and use the elastomeric seal of the present invention can only be derived from Applicant's specification.

In light of the foregoing amendments and remarks, Applicant respectfully requests that the rejections of the claims under 35 U.S.C. § 102 (b) and (e), and 35 U.S.C. § 103 be withdrawn, the application be allowed and pass to issuance.

Respectfully submitted,

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